

REMARKS

This amendment is in response to the Final Rejection of the pending claims in the Office Action of September 12, 2005.

Claims 1 through 13 and 15 through 21 are currently pending in the application.

Claims 1 through 13 and 15 through 21 have been amended herein. Claim 14 was previously canceled herein. No new matter has been entered to the disclosure as the amendment clearly complies with 35 U.S.C. § 132. The amendments are for formalistic reasons and to clarify the invention. The amendments are made without prejudice or disclaimer.

Applicant respectfully requests reconsideration of the rejections.

35 U.S.C. § 102(e) Anticipation Rejections

Anticipation Rejection Based on Wood *et al.* (U.S. Patent 6,453,127)

Claims 1 through 5, 7 through 12, and 15 through 21 were rejected under 35 U.S.C. § 102(e) as being anticipated by Wood *et al.* (U.S. Patent 6,453,127) ("Wood"). Applicant respectfully traverses this rejection.

Applicant asserts that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Regarding claim 1, in the Office Action Applicant's argument that Wood does not describe a printing device incorporating a web server was found to be unpersuasive. *Final Office Action mailed September 12, 2005*, p. 2. It was asserted in the Office Action that Wood discloses a copier or printer apparatus comprising a web server. *Id.* It was further asserted that a printing device incorporating a web server does not limit the web server to being located within the printing device. *Id.* Yet further, it was asserted that the term "incorporating" could be defined as joining devices. *Id.*

Applicant has amended claim 1 to recite "providing a web server inside said printing device" to make it clear that the web server is located inside the printing device, not in another device. This should resolve the issue regarding the interpretation of presently

amended independent claim 1. While the paragraph in the "Summary of the Invention" section of Wood could arguably appear at first to disclose a copier or printer apparatus comprising a web server, such paragraph describes "a copier or printer apparatus . . . the apparatus comprising a marking engine for printing copies of information . . . and a network web server . . . for communicating requirements for a print job . . . for printing by the marking engine." *Column 1 line 60 to Column 2 line 4.* Such paragraph suffers from the same ambiguity as that directed to independent claim 1 regarding the term "incorporating." Such paragraph may be read as disclosing a copier or printer apparatus (a single device) that includes a marking engine (as part of the apparatus) and a web server (as part of the apparatus), or as a copier or printer apparatus (system or at least multiple devices) that includes a marking engine (copier or printer device) and a web server (incorporated in a separate computer). Applicant asserts that the specification and drawings only describe as a copier or printer apparatus (system or at least multiple devices) that includes a marking engine (copier or printer device) and a web server (incorporated in a separate computer). Further, Applicant asserts that the specification and drawings do not describe a marking engine (as part of the apparatus) and a web server (as part of the apparatus).

The following quote is illustrative of the description of the invention in the specification:

The system 10 includes a plurality of remote workstations 11, 11', 11" connected through the Internet or an intranet network 12 to one or more computers 30, 30' through the Internet or an intranet network 12 to one or more computers 30, 30' running Web Server software. The computers 30, 30' are each connected either directly or over a similar communication network with a respective copier/printer 15, 15'. Typically the computers 30, 30' may be placed upon or next to the respective copier/printer 15, 15'. The computers 30, 30' each also acts as a respective file server to store documents or alternatively the file server may be separate from the respective computers 30, 30'. The computers 30, 30' each stores print jobs in a queue for transmission to respective marking engines 15, 15'.

Column 2, lines 50 to 62.

Wood clearly describes that "the web server software [is] resident on computer 30." *Column 3, lines 3 to 5. See also, Column 5, lines 3 to 6; Column 5, line 65 to Column 6, line 1.* The computers in Wood are distinct from the workstations and printers. *See, e.g., FIGS. 1 & 2.* There is never any reference to placing the web server 32 inside the copier/printer 15. There is never any reference to integrating computer 30 and copier/printer 15 into a single device. Wood clearly did not contemplate providing a web server inside a printing device.

The remainder of the description of the Wood invention clearly supports the second interpretation of the ambiguous paragraph.

However, even if the first interpretation is chosen, Applicant asserts that Wood does not describe “[t]he identical invention . . . in as complete detail as is contained in” presently amended claim 1. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); *see also* M.P.E.P. § 2131. The paragraph in question does not provide a sufficient description of the Wood invention to describe the element of the claimed invention of presently amended independent claim 1 calling for “a web server inside said printing device”. Applicant asserts that no where in Wood can possibly describe such an element of the claimed invention of presently amended independent claim 1. Additionally, even under the first interpretation, Applicant asserts that anticipation of the claimed invention under 35 U.S.C. § 102 requires that the elements of the alleged prior art “must be arranged as required by the claim.” M.P.E.P. § 2131. The paragraph directed to the Summary of the Invention of Wood simply does not meet this burden. Furthermore, even if the paragraph in question is viewed as describing an embodiment contrary to all of the embodiments described in the detailed portion of the Wood specification, the paragraph does not identically describe all of the other elements of presently amended claim 1 to anticipate the claimed invention under 35 U.S.C. § 102. Therefore, presently amended independent claim 1 is allowable.

Claims 2 through 5 and 7 through 12 are allowable for at least the reason of depending from allowable presently amended independent claim 1.

Regarding claim 15, assuming such claim would be interpreted to view the “incorporating” language of claim 15 similar to presently amended independent claim 1, Applicant has amended independent claim 15 to recite “a web server incorporated within said printing device.” Applicant asserts that such amendment resolves such a claim interpretation issue. Regarding the claim interpretation issue regarding the “Summary of the Invention” directed to whether or not such paragraph of Wood arguably appears at first to disclose a copier or printer apparatus comprising a web server, Applicant asserts that the paragraph describes “a copier or printer apparatus . . . the apparatus comprising a marking engine for printing copies of information . . . and a network web server . . . for communicating requirements for a print job . . . for printing by the marking engine.” *Column 1 line 60 to Column 2 line 4*. Applicant asserts that such paragraph suffers from the same ambiguity that

concerns the term "incorporating." Applicant asserts that such paragraph may be read as disclosing a copier or printer apparatus (a single device) that includes a marking engine (as part of the apparatus) and a web server (as part of the apparatus), or as a copier or printer apparatus (system or at least multiple devices) that includes a marking engine (copier or printer device) and a web server (incorporated in a separate computer). The only interpretation of this paragraph supported by the description and drawings of the invention is that Wood describes as a copier or printer apparatus (system or at least multiple devices) that includes a marking engine (copier or printer device) and a web server (incorporated in a separate computer).

The following quote is illustrative of the description of the invention in the specification:

The system 10 includes a plurality of remote workstations 11, 11', 11'' connected through the Internet or an intranet network 12 to one or more computers 30, 30' running Web Server software. The computers 30, 30' are each connected either directly or over a similar communication network with a respective copier/printer 15, 15'. Typically the computers 30, 30' may be placed upon or next to the respective copier/printer 15, 15'. The computers 30, 30' each also acts as a respective file server to store documents or alternatively the file server may be separate from the respective computers 30, 30'. The computers 30, 30' each stores print jobs in a queue for transmission to respective marking engines 15, 15'.

Column 2, lines 50 to 62.

Wood clearly describes that "the web server software [is] resident on computer 30." *Column 3, lines 3 to 5. See also, Column 5, lines 3 to 6; Column 5, line 65 to Column 6, line 1.* The computers in Wood are distinct from the workstations and printers. *See, e.g., FIGS. 1 & 2.* There is never any reference to incorporating the web server 32 within the copier/printer 15. There is never any reference to integrating computer 30 and copier/printer 15 into a single device. Wood clearly did not contemplate incorporating a web server within a printing device. The description of the invention clearly supports the second interpretation of the ambiguous paragraph.

However, even if the first interpretation is chosen, Applicant asserts that Wood does not describe "[t]he identical invention . . . in as complete detail as is contained in" presently amended claim 15. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); *see also* M.P.E.P. § 2131. The paragraph in question does not provide a sufficient description of the Wood invention to describe the element of the claimed invention of presently amended

independent claim 1 calling for “a web server incorporated within said printing device” and there is no where else in Wood that could possibly describe that element. Additionally, even under the first interpretation, anticipation of the claimed invention under 35 U.S.C. § 102 requires that the elements of the alleged prior art “must be arranged as required by the claim.” M.P.E.P. § 2131. The paragraph in question simply does not meet that burden. Furthermore, even if the paragraph in question is viewed as describing an embodiment contrary to all of the embodiments described in the detailed portion of the Wood specification, the paragraph does not identically describe all of the other elements of presently amended independent claim 15 to anticipate the claimed invention under 35 U.S.C. § 102. Therefore, presently amended independent claim 15 is allowable.

Claims 16 through 19 are allowable for at least the reason of depending from allowable presently amended independent claim 15.

Regarding claim 20, assuming such claim would be interpreted to view the “incorporating” language of claim 20 similar to claim 1, Applicant has amended claim 20 to recite “said printing device internally incorporating a web server.” Applicant asserts that such amendment resolves such a claim interpretation issue. Regarding the claim interpretation issue regarding the “Summary of the Invention” directed to whether or not such paragraph of Wood arguably appears at first to disclose a copier or printer apparatus comprising a web server, Applicant asserts that the paragraph describes “a copier or printer apparatus . . . the apparatus comprising a marking engine for printing copies of information . . . and a network web server . . . for communicating requirements for a print job . . . for printing by the marking engine.” *Column 1 line 60 to Column 2 line 4.* Applicant asserts that such paragraph suffers from the same ambiguity that concerns the term “incorporating.” Applicant asserts that such paragraph may be read as disclosing a copier or printer apparatus (a single device) that includes a marking engine (as part of the apparatus) and a web server (as part of the apparatus), or as a copier or printer apparatus (system or at least multiple devices) that includes a marking engine (copier or printer device) and a web server (incorporated in a separate computer). The only interpretation of this paragraph supported by the description and drawings of the invention is that Wood describes as a copier or printer apparatus (system or at least multiple devices) that includes a marking engine (copier or printer device) and a web server (incorporated in a separate computer).

The following quote is illustrative of the rest of the specification:

The system 10 includes a plurality of remote workstations 11, 11', 11" connected through the Internet or an intranet network 12 to one or more computers 30, 30' running Web Server software. The computers 30, 30' are each connected either directly or over a similar communication network with a respective copier/printer 15, 15'. Typically the computers 30, 30' may be placed upon or next to the respective copier/printer 15, 15'. The computers 30, 30' each also acts as a respective file server to store documents or alternatively the file server may be separate from the respective computers 30, 30'. The computers 30, 30' each stores print jobs in a queue for transmission to respective marking engines 15, 15'.

Column 2, lines 50 to 62.

Wood clearly describes that "the web server software [is] resident on computer 30." *Column 3, lines 3 to 5. See also, Column 5, lines 3 to 6; Column 5, line 65 to Column 6, line 1.* The computers in Wood are distinct from the workstations and printers. *See, e.g., FIGS. 1 & 2.* There is never any reference to internally incorporating the web server 32 in the copier/printer 15. There is never any reference to integrating computer 30 and copier/printer 15 into a single device. Wood clearly did not contemplate incorporating a web server internally in a printing device. The rest of the patent clearly supports the second interpretation of the ambiguous paragraph.

However, even if the first interpretation is chosen, Wood does not describe "[t]he identical invention . . . in as complete detail as is contained in" presently amended claim 20. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); *see also* M.P.E.P. § 2131. The paragraph in question does not provide a sufficient description of the Wood invention to describe the element of the claimed invention of presently amended independent claim 1 calling for "a web server incorporated within said printing device" and there is no where else in Wood that could possibly describe that element. Additionally, even under the first interpretation, anticipation of the claimed invention under 35 U.S.C. § 102 requires that the elements of the alleged prior art "must be arranged as required by the claim." M.P.E.P. § 2131. Applicant asserts that the paragraph in question simply does not meet that burden. Furthermore, even if the paragraph in question is viewed as describing an embodiment contrary to all of the embodiments described in the detailed portion of the Wood specification, the paragraph does not describe all of the other elements of presently amended claim 20. Therefore, presently amended independent claim 20 is novel and allowable.

Regarding claim 21, the Examiner rejected Applicant's argument that Wood does not describe a web server within a printing device. *Final Office Action mailed September 12, 2005, p. 2.* The Examiner asserted that Wood discloses a copier or printer apparatus comprising a web server. *Id.*

The Examiner relied upon a paragraph in the "Summary of the Invention" section of Wood. The paragraph could arguably appear at first to disclose a copier or printer apparatus comprising a web server. The paragraph discloses "a copier or printer apparatus . . . the apparatus comprising a marking engine for printing copies of information . . . and a network web server . . . for communicating requirements for a print job . . . for printing by the marking engine." *Column 1 line 60 to Column 2 line 4.* This paragraph suffers from the same ambiguity that the Examiner was concerned about with claims 1, 15, and 20 and the term "incorporating." This paragraph may be read as disclosing a copier or printer apparatus (a single device) that includes a marking engine (as part of the apparatus) and a web server (as part of the apparatus), or as a copier or printer apparatus (system or at least multiple devices) that includes a marking engine (copier or printer device) and a web server (incorporated in a separate computer). The only interpretation of this paragraph supported by the rest of the specification is the second one.

The following quote is illustrative of the rest of the specification:

The system 10 includes a plurality of remote workstations 11, 11', 11" connected through the Internet or an intranet network 12 to one or more computers 30, 30' running Web Server software. The computers 30, 30' are each connected either directly or over a similar communication network with a respective copier/printer 15, 15'. Typically the computers 30, 30' may be placed upon or next to the respective copier/printer 15, 15'. The computers 30, 30' each also acts as a respective file server to store documents or alternatively the file server may be separate from the respective computers 30, 30'. The computers 30, 30' each stores print jobs in a queue for transmission to respective marking engines 15, 15'.

Column 2, lines 50 to 62.

Wood clearly discloses that "the web server software [is] resident on computer 30."

Column 3, lines 3 to 5. See also, Column 5, lines 3 to 6; Column 5, line 65 to Column 6, line 1. The computers in Wood are distinct from the workstations and printers. *See, e.g., FIGS. 1 & 2.* There is never any reference to a web server 32 within a copier/printer 15. There is never any reference to integrating computer 30 and copier/printer 15 into a single device. Wood clearly did not contemplate a web server within a printing device. The description of

the invention clearly supports the second interpretation of the ambiguous paragraph.

However, even if the first interpretation is chosen, Applicant asserts that Wood does not describe “[t]he identical invention . . . in as complete detail as is contained in” presently amended claim 21. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); *see also* M.P.E.P. § 2131. The paragraph in question is not detailed enough to describe “said printing device internally incorporating a web server” and there is no where else in Wood that could possibly describe that element. Additionally, even under the first interpretation, anticipation requires that the elements of the alleged prior art “must be arranged as required by the claim.” M.P.E.P. § 2131. The paragraph in question simply does not meet that burden.

Furthermore, even if the paragraph in question is viewed as describing an embodiment contrary to all of the embodiments described in the detailed portion of the Wood specification, the paragraph does not identically describe all of the other elements of presently amended independent claim 21 to anticipate the claimed invention under 35 U.S.C. § 102. Therefore, presently amended independent claim 21 is allowable.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on Wood

Claims 6 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wood. Applicant respectfully traverses this rejection, as hereinafter set forth.

Applicant further asserts that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant’s disclosure.

Applicant asserts that claims 6 and 13 are allowable for at least the reason of depending from allowable presently amended independent claim 1.

After carefully considering the cited prior art, the rejections, and the Examiner's comments, Applicant has amended the claimed invention to clearly distinguish over the cited prior art.

Applicant submits that claims 1 through 13 and 15 through 21 are clearly allowable over the cited prior art.

Applicant requests entry of this amendment for the following reasons:

The amendment is timely filed.

The amendment does not require any further search or consideration.

The amendment places the application in condition for allowance.

Respectfully submitted,



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